REMARKS

This responds to the Office Action mailed on June 20, 2006, and the references cited therewith. Claims 1-11, 17, 29-33 and 35-46 are now pending in this application. Applicants do not admit that the cited references are prior art and reserve the right to "swear behind" each of the cited references as provided under 37 C.F.R. 1.131.

§103 Rejection of the Claims

Claims 1-9, 17, 29-33, 35-43 and 45-46 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Nahan et al. (U.S. 5,664,111) in view of Fisher et al. (U.S. 5,835,896).

The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). To do that the Examiner must show that some objective teaching in the prior art or some knowledge generally available to one of ordinary skill in the art would lead an individual to combine the relevant teaching of the references. *Id.*

The *Fine* court stated that:

> Obviousness is tested by "what the combined teaching of the references would have suggested to those of ordinary skill in the art." *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 878 (CCPA 1981)). But it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." *ACS Hosp. Sys.*, 732 F.2d at 1577, 221 USPQ at 933. And "teachings of references can be combined *only* if there is some suggestion or incentive to do so." *Id.* (emphasis in original).

The M.P.E.P. adopts this line of reasoning, stating that

> In order for the Examiner to establish a *prima facie* case of obviousness, three base criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *M.P.E.P.* § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)).

An invention can be obvious even though the suggestion to combine prior art teachings is not found in a specific reference. *In re Oetiker*, 24 USPQ2d 1443 (Fed. Cir. 1992). At the same time, however, although it is not necessary that the cited references or prior art specifically suggest making the combination, there must be some teaching somewhere which provides the suggestion or motivation to combine prior art teachings and applies that combination to solve the same or similar problem which the claimed invention addresses. One of ordinary skill in the art will be presumed to know of any such teaching. (See, e.g., *In re Nilssen*, 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988) and *In re Wood*, 599 F.2d 1032, 1037, 202 USPQ 171, 174 (CCPA 1979)).

Claims 1-9, 17, 29-33, 35-43, 45 and 46

Among the differences, claim 1 recites "notifying the user when the entry in the variable price schedule is reached." In the Response to Argument section, the Office indicated the following regarding the variable price schedule:

> Nahan discloses a "historical record of prices" which is interpreted as a variable price schedule in col. 4, lines 54-58.[1]

Applicants do not admit that the terms "historical record of prices" and "variable price schedule" are interpreted as the same. The "historical record of prices" relates to a list of prices at which a specific piece of artwork has been previously sold. The "variable price schedule" relates to the schedule of pricing at which an item can be bought. Regardless of whether these two terms are interpreted as the same, Nahan does not disclose the notifying of a user when an entry in the variable price schedule is reached.

The Office indicated that Fisher teaches this notifying limitation at column 6, lines 46-49 and column 7, lines 1-7.[2] Applicants respectfully traverse this assertion. These sections of Fisher relate to notifying a user of an online auction when they are outbid and notifying the

[1] Office Action at page 11.
[2] See Office Action at page 3.

winning and losing bidders of the final winning bid. These sections do not disclose that a user is notified when an entry in a variable price schedule is reached.

Accordingly, because the cited references do not disclose or suggest all of the claim limitations, Applicants respectfully submit that the rejections of claims 1 and 17 under 35 U.S.C. §103 have been overcome. Additionally, because claims 2-9, 29-33, 45-43, 45 and 46 depend from and further define claim 1, Applicants respectfully submit that the rejections of claims 2-9, 29-33, 45-43, 45 and 46 under 35 U.S.C. §103 have been overcome.

Claim 8

Additionally, with regard to claim 8, among the differences, claim 8 recites "wherein acceptance of the reminder command in the receiving of a reminder command from the user is contingent on the receipt of contact information in a step of receiving contact information for the user, but wherein the presenting of the item is independent of the receipt of any contact information from the user." The Office Action indicated that

> [i]t would have been obvious to one having ordinary skill in the art at the time of the invention was made to have an acceptance of the reminder command in the receiving of a reminder command from the user is contingent on the receipt of contact information in a step of receiving contact information for the user, but wherein the presenting of the item is independent of the receipt of any contact information from the user and to modify in Nahan because such a modification would allow Nahan to allow the user to send a response indicating that the user agrees with the price.[3]

However, Nahan indicates that a buyer sits at a table with the salesperson who assists in viewing the artwork on the network. Accordingly, there is no need to send a response indicating agreement with the price.

Thus, Applicants respectfully object to the taking of official notice since it would not have been obvious to include such a contingency, and pursuant to M.P.E.P. § 2144.03, Applicants traverse the assertion of official notice and requests that the Examiner cite a reference that teaches the missing elements. If the Examiner cannot cite a reference that teaches the missing elements, Applicants respectfully request that the Examiner provide an affidavit that describes how the missing elements are present in the prior art. If the Examiner cannot cite a

[3] Office Action at page 6.

reference or provide an affidavit, Applicants request withdrawal of the rejection and reconsideration and allowance of claim 8.

Claims 10-11 and 44

Claims 10-11 and 44 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Nahan et al. in view of Fisher et al. and further in view of Godin et al. (U.S. 5,890,138). Applicants respectfully disagree with this rejection.

With regard to claim 10, among the differences, claim 10 recites "wherein the presenting of the item information includes presenting the plurality of price selections for the item including a plurality of time-separated price choices from a falling-price schedule." With regard to claim 11, among the differences, claim 11 recites "displaying a present purchase control button next to the present price and a future purchase control button next to the future price."

In the Response to Arguments section, the Office indicated that

> Godin teaches the schedule for the falling prices are presented to the user and a future purchase control button at col. 3, lines 48-52 and col. 6, lines 50-56.[4]

Applicants respectfully traverse this assertion. Godin at col. 3, lines 48-52 indicates that "[a]ll products that are slated to be auctioned are not listed . . ." and that can be performed by "time designation control."[5] Godin at col. 6, lines 50-56 relates to an auction wherein the prices are decreased and the user selects a button if they decide to purchase at a given price. However, these sections of Godin do not disclose that the schedule for the falling prices is presented to the user. Only that the price falls over time. Accordingly, the user does not know schedule of the times and associated falling prices. Moreover, these sections of Godin do not disclose a future purchase control button.

With regard to claim 44, among the differences, claim 44 recites "wherein the communicating of the variable price schedule includes displaying a future price and a future purchase control button next to it." As described above in the discussion of claims 10-11, Godin does not disclose this limitation.

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[4] Office Action at page 11.
[5] Godin at column 3, lines 48-52.

Accordingly, because the cited references do not disclose or suggest all of the claim limitations, Applicants respectfully submit that the rejections of claims 10-11 and 44 under 35 U.S.C. §103 have been overcome.

CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicants' attorney at (612) 371-2103 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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By _____
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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 21 day of August, 2006.

Peter Rebuffoni
Name

Signature